The opinion in support of the decision being entered today was <u>not</u> written for publication and is <u>not</u> binding precedent of the Board.
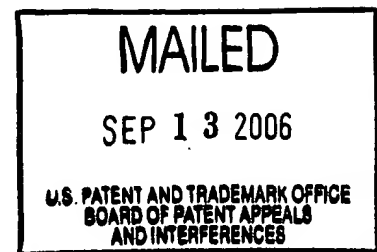
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

<u>Ex parte</u> HONGHAI SHEN AND YUDONG SUN

Appeal No. 2006-2006
Application No. 09/512,738

ON BRIEF

Before KRASS, BARRY, and HOMERE, <u>Administrative Patent Judges</u>.

KRASS, <u>Administrative Patent Judge</u>.

<u>DECISION ON APPEAL</u>

This is a decision on appeal from the examiner's refusal to allow claims 1-54.

The invention pertains to a system that provides dynamic Web pages with separated scripts and HTML (hyper-text markup language) code so that the Web pages may be edited by an HTML editor.

Representative independent claim 1 is reproduced as follows:

1. Within a document server, a computer-implemented method for processing a request for a document comprising at least one hypertext markup language (HTML) element, the method comprising:

parsing the requested document to generate therefrom a corresponding document object model (DOM) including at least one object;

obtaining a transformation instruction directed to a first object of the DOM, the first object having a value;

transforming the first object by changing the value thereof in accordance with the transformation instruction; and

flattening the DOM to generate therefrom a corresponding transformed document.

The examiner relies on the following references:

Jamtgaard et al. (Jamtgaard)	6,430,624	Aug. 06, 2002 (filed Feb. 14, 2000)
Tadokoro et al. (Tadokoro)	6,463,352	Oct. 08, 2002 (filed Aug. 25, 1999)
Maslov	6,538,673	Mar. 25, 2003 (eff. filing date Aug. 23, 1999)
Lipkin	6,721,747	Apr. 13, 2004 (eff. filing date Jan. 14, 2000)

Claims 1-52 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner offers Jamtgaard and Lipkin with regard to claims 1-4, 7-14, 17-24, 27-39, and 40-54, adding Maslov with regard to claims 5, 15, and 25, but adding Tadokoro with regard to claims 6, 16, and 26.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish

a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071,

1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the

factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459,

467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277

F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In particular, the examiner must

show that there is a teaching, motivation, or suggestion of a motivation to combine references

relied on as evidence of obviousness. Id. 277 F.3d at 1343, 61 USPQ2d at 1433-34. The

examiner cannot simply reach conclusions based on the examiner's own understanding or

experience – or on his or her assessment of what would be basic knowledge or common sense.

Rather, the examiner must point to some concrete evidence in the record in support of these

findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the

examiner must not only assure that the requisite findings are made, based on evidence of record,

but must also explain the reasoning by which the findings are deemed to support the examiner's

conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art

teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or

suggestion may be implicit from the prior art as a whole, rather than expressly stated in the

references. The test for an implicit showing is what the combined teachings, knowledge of one

of ordinary skill in the art, and the nature of the problem to be solved as a whole would have

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suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d

1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-

17 (Fed. Cir. 2000). See also In re Thrift, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed.

Cir. 2002). These showings by the examiner are an essential part of complying with the burden

of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24

USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the

applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then

determined on the basis of the evidence as a whole and the relative persuasiveness of the

arguments. See Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ 685, 687 (Fed. Cir. 1986); In

re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531

F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976). Only those arguments actually made

by appellant have been considered in this decision. Arguments which appellant could have made

but chose not to make in the brief have not been considered and are deemed to be waived [see 37

CFR §41.37(c)(1)(vii) (2004)].

With regard to independent claim 1, the examiner contends that Jamtgaard discloses the

claimed method but for the limitation of "transforming the first object by changing the value

thereof in accordance with the transformation instruction." The examiner turns to Lipkin for this

limitation, specifically pointing to column 69, line 1, through column 71, line 15, arguing that

Lipkin discloses a method in which a transformation of a DOM (Document Object Model) object

consists of changing the underlying value of that object.

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The examiner concludes that it would have been obvious "to have combined the methods of Jamtgaard with the method of Lipkin because it would have allowed for a transformation to occur that was transparent to the user" (answer-page 4).

Appellant argues that Jamtgaard is directed only to reformatting existing web pages to change their format from a first format, e.g., HTML, to another format so that they may be viewed on various devices, while Lipkin is directed to generating, or creating, viewable pages from an XSP model page to display that viewable page on various devices. Appellant argues that the references are "quite different" (principal brief-page 22).

Basically, appellant offers two arguments. First, appellant contends that Lipkin fails to teach or suggest the features that the examiner concedes are missing from Jamtgaard, i.e., "transforming the first object by changing the value thereof in accordance with the transformation instruction." Further, appellant argues that there was inadequate motivation to modify Jamtgaard in view of Lipkin, as suggested by the examiner.

Regarding the first argument, appellant contends that Jamtgaard discloses only two general types of operations performed on XSP model pages, either inserting new command lines containing processing instructions and new links to create the contents of the viewable page that is to be displayed (appellant argues that such insertion of new commands cannot reasonably be read as "changing" the value of a first object of a DOM), or the formatting of the XSP model page for a particular display type. The formatting is accomplished by applying widgets (input fields, buttons, hyperlinks, etc.) and an XSLT stylesheet to the page. However, according to

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appellant, Lipkin fails to teach or suggest that the attachment of widgets to the page content

changes the content of the page in any way. Rather, contends appellant, attaching these widgets

only modifies how the content is displayed, not any underlying value.

Thus, appellant concludes that Lipkin is no more relevant to the instant invention than

Jamtgaard since Lipkin fails to disclose any modification of an underlying value of a DOM

object.

With regard to the combination, appellant asserts that even if Lipkin could, arguably, be

read as disclosing an underlying modification of data, the skilled artisan would still not have

been motivated to modify Jamtgaard as the examiner alleges.

In particular, appellant argues that the examiner's rationale for making the combination,

viz., "'to allow for a transformation to occur that is transparent to the user,'" is erroneous because

Jamtgaard already provides an automatic reformatting of content that is transparent to the user, so

Jamtgaard would not need to be modified to provide a feature that already exists (see page 25 of

the principal brief).

Moreover, appellant reasons as follows:

> *Jamtgaard* is directed to <u>reformatting an existing document</u> so
> that it may be displayed on a particular client, while *Lipkin* is
> directed to <u>creating and formatting a document from scratch</u> so
> that it may be viewed on a particular client. Thus, while the
> method of *Jamtgaard* is tailored to operate on an existing mark-up
> language page (*e.g.,* HTML), *Lipkin* is tailored to operate on a
> specific XSP model page, upon which command lines are inserted,
> and a style sheet is applied to form a mark-up language page.
> Accordingly, even in the most general sense, *Jamtgaard* and

Lipkin are : (1) directed to operate in two distinctly different roles
(reformatting vs. creation); and (2) use as a starting point two distinctly
different document types (an existing document vs. an XSP model).
(principal brief-page 25).

We have carefully considered the evidence before us, including, inter alia, the disclosure

of the applied references and the arguments of appellant and the examiner, and we conclude

therefrom that the examiner has not established the requisite prima facie case of obviousness,

within the meaning of 35 U.S.C. § 103.

We agree with appellant that what is conceded by the examiner to be missing from

Jamtgaard, viz., "transforming the first object by changing the value thereof in accordance with

the transformation instruction," is not taught by Lipkin, as is alleged by the examiner.

Accordingly, since neither of the applied references teaches or suggests one of the claim

limitations, the rejection of claim 1 under 35 U.S.C. § 103 must be reversed.

In particular, the examiner points to column 10, line 20, through column 11, line 12, of

Jamtgaard, for a receipt of a transformation instruction that is directed at a first object of the

DOM tree, which has a value. The examiner concedes that Jamtgaard does not disclose the

transformation of the object involving changing a value of the object based on the transformation

instruction. But, the examiner relies on Lipkin, at column 69, lines 1-54, for the alleged teaching

of the use of a transformation instruction to change the value of an object in a DOM tree in a way

that is transparent to the user.

The examiner reasons that the transformation occurring in Jamtgaard is a method of

changing the format of the document, while the transformation occurring in Lipkin is a method

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of changing the contents/values of the DOM tree, and so the combination of these references would have provided a method in which both the format/style of a document and the actual content of a document could be changed and adapted in a way that is transparent to the user.

In our view, the examiner errs in finding, at column 69, lines 1-54, of Lipkin, the changing of a value of an object based on a transformation instruction. We find, in this passage, as did appellant, that Lipkin indicates an insertion point for the next DOM node (column 69, lines 18-20), or an insertion point for new command lines containing processing instructions, but we find no teaching or suggestion that the insertion of these lines changes the value of any underlying object.

In column 67 of Lipkin, there is a model document before insertion of command lines and, in column 68, there is a model document after insertion of command lines. A comparison of these two documents seems to show that there is no value change in anything that might be construed as an object. Thus, to the extent that the examiner is relying on Lipkin's process of inserting new command lines, since that is what column 69 of Lipkin seems to be concerned with, we agree with appellant that this is "simply not equivalent to the recited transformation of 'the first object by changing the value thereof in accordance with the transformation instruction.'" (reply brief-page 5).

Thus, since neither of the applied references describes or suggests "transforming the first object by changing the value thereof in accordance with the transformation instruction," the rejection of claim 1 under 35 U.S.C. § 103 must be reversed. Moreover, since each of the other
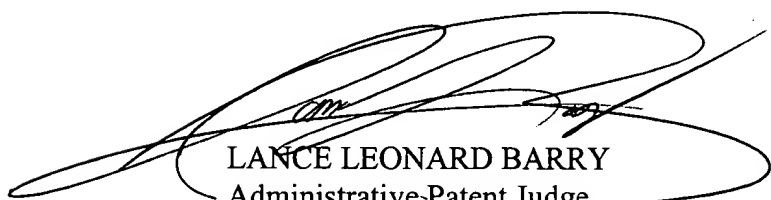
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independent claims 11 and 21 also includes this limitation, we will also reverse the rejection of

these claims under 35 U.S.C. § 103, as well as the rejection of claims 2-4, 7-10, 12-14, 17-20,

22-24, 27-39, and 40-54, dependent on the independent claims, under 35 U.S.C. § 103.

Further, we will also reverse the rejection of dependent claims 5, 6, 15, 16, 25, and 26

under 35 U.S.C. § 103 because the secondary references to Maslov and Tadokoro do not provide

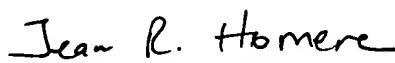for the deficiencies of the primary references.

The examiner's decision rejecting claims 1-54 under 35 U.S.C. § 103 is reversed.

<u>REVERSED</u>

ERROL A. KRASS   )
Administrative Patent Judge   )
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) BOARD OF PATENT
LANCE LEONARD BARRY   )   APPEALS
Administrative Patent Judge   )   AND
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